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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/594,777 | 10/04/2007 | Matthew Trevor Snowden | 24752US (Acergy 57) | 7103 |
| 83942 | 7590 | 10/04/2011 | | |
| Levy & Grandinetti P.O. Box 18385 Washington, DC 20036 | | | EXAMINER ANDRISH, SEAN D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3672 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/594,777 | SNOWDON ET AL. | |
| | Examiner | Art Unit | |
| | SEAN ANDRISH | 3672 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1 - 13 and 15 - 22 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1 - 13 and 15 - 22 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 1 - 22 are objected to because of the following informalities:
 - a. The preamble of the independent apparatus claim should begin with "An"; the preamble of the independent method claim should begin with "A"; and the preamble of each dependent claim should begin with "The".
 - b. Claim 4, line 2: --the-- should be inserted before "flexible"
 - c. Claim 10, line 2: --of the legs-- should be inserted after "lower ends"
 - d. Claim 10, line 3: --of the legs-- should be inserted after "upper ends"
 - e. Claim 19, line 2: --the-- should be inserted before "flexible"
 - f. Claim 21, line 2: "an apparatus" should be changed to --the apparatus--
 - g. Claim 22, line 2: "an apparatus" should be changed to --the apparatus--Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1 - 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The use of the words "it", "its", and "their" as recited in claims 4, 9, 10, 18, and 19 renders the claims indefinite as it is unclear as to which structural element or limitation the term is referring. Structural elements or limitations should always be

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referred to by name. Examiner recommends a thorough review of all of the claims for similar errors.

b. It is unclear as to whether the phrase "the product" as recited in claim 1, line 8 is referring to the rigid elongate product or the flexible elongate product. Similar errors exist in claims 8 and 15.

c. The use of the phrase "and/or" as recited in claims 3 and 17 is considered to be generally confusing as it is not clear to the examiner if applicant is intending to claim the respective limitations together or in the alternative. It is suggested that "and/or" be changed to --at least one of--, or something similar.

4. There is insufficient antecedent basis for the following limitations in the claims:

- a. Claim 10, line 2: "the deck"
- b. Claim 15, lines 5 - 6: "the rigid elongate product"
- c. Claim 15, lines 10 - 11: "the upright position"
- d. Claim 15, line 11: "the horizontal position"

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1 - 13 and 15 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recalde (4,721,411).

Regarding claims 1, 6, 21, and 22, Recalde discloses an apparatus comprising: a tensioner (1384); a structure that is tiltable between upright and substantially horizontal states; the apparatus is operable in a first mode, wherein the longitudinal axis of tiltable structure is at an elevated angle for the departure of rigid elongate product (pipeline 1326) and a second mode for receiving a flexible product, wherein the longitudinal axis of the tiltable structure is substantially horizontal; and a support structure (roller ramp 1336) for diverting the flexible elongate product (pipeline 1326) to the desired curvature (Figs. 41, 45, and 46; column 35, lines 17 - 35; column 36, lines 53 - 58). Examiner explains that although Recalde teaches a tiltable structure for laying rigid pipeline from either a substantially vertical or a substantially horizontal angle of departure, the structure as disclosed by Recalde is capable of laying a flexible pipeline when the apparatus is in the second mode. The claims do not recite any limitations which preclude the use of the apparatus as taught by Recalde for laying either flexible or rigid pipe. Recalde does not explicitly state that the "desired curvature" diverts the flexible product to a more vertical angle, but it would have been an obvious design consideration within the skill in the art.

Regarding claim 2, Recalde further discloses a radius controller and a straightener (1386) (Figs. 41, 45, and 46; column 36, line 19).

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Regarding claims 3 and 17, Recalde further discloses a removable module (1302) (Fig. 45).

Regarding claims 4 and 5, Recalde further discloses the support structure comprises a sheave (rollers 1338, 1340, 1342, 1344) (Figs. 45 - 47; column 35, lines 31 - 32).

Regarding claims 7 and 20, as discussed above the tensioner of the present application is attached to the tiltable structure when in the second mode (Fig. 3). Since the tensioner as taught by Recalde is identical to the tensioner of the present application, Recalde teaches the tensioner is detached from the tiltable structure while in the second mode inasmuch as the tensioner of claimed invention is detached from the tiltable structure.

Regarding claim 8, Recalde discloses all of the claim limitation(s) except for the tiltable structure is operable in the second mode at a range of angles either side of vertical. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the apparatus as disclosed by Recalde such that the tiltable structure can be operated in the second mode at a range of angles either side of vertical to increase the available work space on the deck of the vessel.

Regarding claims 9 and 18, Recalde further discloses the tensioner (1384) in the second mode is located at a position displaced horizontally from a location from which it will be elevated by said tiltable structure in the first mode (Figs. 41, 45, and 46).

Regarding claim 10, Recalde further discloses a pair of legs pivoted to the deck of the vessel at their lower ends and joined by a crossbeam at their upper ends, the tensioner (1118) in the first mode being carried between the legs below the crossbeam (roller track 1144), with a straightener (1114) and radius controller (1160) mounted above the crossbeam and said

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straightener (1114) being detachable when adapting the apparatus into the second mode (Fig. 41). Examiner notes that the crossbeam (1144) is located adjacent tensioner/straightener (1116) and since tensioner (1118) is located below tensioner/straightener (1116), the tensioner (1118) is carried below the crossbeam (see Fig. 41 below). Examiner explains that since the tensioner (1118) can be removed from the tiltable apparatus at any time, it is capable of being detachable when adapting the apparatus into the second mode.

Regarding claim 11, Recalde further discloses wherein the tiltable structure is movable to provide said horizontal displacement of the tensioner (1384) (Figs. 41, 45, and 46).

Regarding claim 12, Recalde further discloses the tiltable structure is connected to the vessel by one or more pivotable arms (track assembly 102) (column 14, lines 43 - 60).

Regarding claim 13, Recalde further discloses a dual hydraulic control system (rams 306p, 306s) (Fig. 9, column 14, lines 43 - 60).

Regarding claims 15 and 16, Recalde further discloses detaching certain operating equipment (sprocket chain sets 596, 598, 600) (column 21, lines 41 - 51).

Regarding claim 19, Recalde teaches an overboarding sheave (roller ramp 1336) for diverting the elongate article to a desired angle (Fig. 45; column 36, lines 53 - 58). Since elongate articles laid when the apparatus is in the first mode are already vertically oriented, there is no need for an overboarding sheave and it would have been considered obvious to one of ordinary skill in the art to detach the sheave (1336) to simplify the apparatus for laying elongate articles by reducing the number of system components and decreasing maintenance costs.

Response to Arguments

8. Applicant's arguments filed 12 July 2011 have been fully considered but they are not persuasive.

Applicant argues that Recalde does not teach, suggest, or motivate one of ordinary skill in the art to an apparatus having the two claimed modes as defined by the tensioner axis with the rigid elongate product or the flexible elongate product. Examiner replies that although Recalde teaches a tiltable structure for laying rigid pipeline from either a substantially vertical or a substantially horizontal angle of departure, the structure as disclosed by Recalde is capable of laying a flexible pipeline when the apparatus is in the second mode. The claims do not recite any limitations which preclude the use of the apparatus as taught by Recalde for laying either flexible or rigid pipe. It would have been obvious to modify the apparatus as taught by Recalde so that the apparatus lays rigid elongate product when in a first mode and flexible elongate product when in a second mode to increase the range of scenarios for which the apparatus can be used and to minimize the amount of equipment to be carried on a vessel for laying two distinct types of elongate product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN ANDRISH whose telephone number is (571)270-3098. The examiner can normally be reached on Mon - Fri, 7:30am - 5:00pm, Alternate Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean Andrish/
Examiner, Art Unit 3672